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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,545	06/24/2003	Gioacchino Coppi	2865-383	7778

23117 7590 05/27/2004

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EXAMINER

SIRMONS, KEVIN C

ART UNIT PAPER NUMBER

3763

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,545

Applicant(s)

COPPI ET AL.

Examiner

Kevin C. Simons

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/24/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the balloons elements, when not inflated, are contained within the profile of the tubular body onto which they are fitted (claim 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 27 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In an apparatus claim, very little patentable weight is given to a product by process claim. As long as the end structure is the same then the prior art meets the requirements of the claim. See MPEP 2112.02

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the thickness and the catheter wall." There is insufficient antecedent basis for this limitation in the claim.

As to claim 16, applicant's claim is incomplete; therefore, it is unclear what applicant is attempting to claim.

Claim 19 recites the limitation "the first greater external diameter." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Melinyshyn et al U.S. Pat. No. 4,840,690.

Melinyshyn discloses a long and flexible, hollow, tubular body (11) having an insertion end and connection end (figs. 1, 2 and 4) intended to remain outside the body, and at the insertion end, at least two elements (16, 18) which are expandable/contractible by means of external operation and which are located on said tubular body at a fixed distance from each other such as to be able to operate one upstream and the other downstream of a given section of a

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vessel (figs. 1, 2 and 4), said expandable/contractible elements being adapted and/or being able to be adapted, with regard to the diameter in the expanded condition, to the diameter of the vessels (16, 18 are fully capable of performing the function as set forth above); and discharge ducts which are provided inside the thickness of the catheter wall (1b, 1d).

Claims 13-15, 17, 18, 20, 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by W. Bell U.S. Pat. No. 3,509,884.

Bell discloses a catheter (figs. 1 and 2); as to claim 14, (figs. 1-3); as to claim 15, (6); as to claims 17, 18, (figs. 1-3); as to claim 20, (figs. 1-2); as to claim 21, (the device of bell is fully capable of blocking flow); as to claim 22, (it is the examiner's position that Bell's catheter in its normal and usual operation would necessarily perform the method claimed because the are structurally equivalent; as to claim 27, (figs. 1 and 2).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonkman et al U.S. Pat. No. 6,464,664.

Jonkman discloses a catheter substantially as claimed specifically including expandable/contractible elements having different diameters in the expanded condition (fig. 8); as to claim 18, (fig. 8)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over W. Bell U.S. Pat. No. 3,509,884.

Bell discloses a catheter substantially as claimed except for wherein the first greater external diameter is of the order of magnitude of 12-13 French (about 3.9 mm), preferably not greater than 14 French (4.2mm) while the second smaller diameter is of the order of magnitude of 5 French (about 1.5mm). It would have been an obvious matter of design choice to change the dimension of the balloons, since a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 16, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al U.S. Pat. No. 5,628,719 in view of Jonkman et al.

Hastings discloses a catheter substantially (fig. 23) as claimed except for supplying and discharge ducts within the thickness of the catheter walls. Jonkman discloses supplying and discharge ducts within the thickness of the catheter walls. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the supplying

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and discharge ducts within the thickness of the catheter walls **for inflating or deflating the balloons**. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the supplying and discharge ducts within the thickness of the catheter walls, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); as to claim 26, (fig. 23).

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.



Kevin C. Sirmons
Patent Examiner
5/24/05